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10/016,079	12/12/2001	Yutaka Hasegawa	SUZU:002	6932

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EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/016,079	HASEGAWA, YUTAKA	
	Examiner	Art Unit	
	PINKY BOVEJA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *17-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communication filed on 12/16/2008.

2. Claims 17-20 have been cancelled. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-16, are rejected under 103(a) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka) in view of the article titled "Beatnik Partners With Ex'pression to Advance the Art of Web Sonification," published in PR Newswire on October 14, 1999 on page 1 (hereinafter Beatnik), and further in view of Official Notice.

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles contribution and distribution of digital music contents and presentation of advertising messages to users of the information service via plurality of user terminals including first and second user terminals over a computer network (abstract, page 1 paragraphs 2 and 12-16, and page 8 paragraph 139), the system comprising: a first database containing advertising messages provided from advertisers (page 1 paragraph 16, page 6 paragraph 117, page 10 paragraph 181, page 15

paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15, 23, and 27) that subscribe to the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a second database containing a plurality of digital music contents which are subject to legal protection on behalf of content proprietors (page 1 paragraphs 1 and 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraph 139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a presenting section that delivers the advertising messages over the computer network to the users via the plurality of user terminals (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8); a receiving section that receives a request for delivery of the registered digital music content from the second user terminal (page 1 paragraph 2, page 8 paragraph 139, and page 9 paragraph 152); a distributing section that delivers the registered digital music content to another of the user via the second user terminal when receiving the request from the another user over the computer network (page 1 paragraph 2, page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraphs 134 and 139, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietor of the registered digital music content identified in the status information (page 1 paragraphs 2 and 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 139 and 142, page 12 paragraph 198 and 200, page

13 paragraph 226, page 20 paragraph 343, and Figure 20); a contributing section that receives digital music content from one of the users via the first user terminal wherein the users are different from the identified content proprietors (page 1 paragraph 2, page 8 paragraphs 138 and 139, page 11 paragraph 190, page 20 paragraph 343, and Figure 15).

Yamanaka is silent about the digital music content representing a music piece that has been modified as the modified digital music content by the one user, who is different from the identified content proprietor. Beatnik teaches the digital music content representing a music piece that has been modified as the modified digital music content by the one user, who is different from the identified content proprietor (page 1 paragraphs 2 and 3 and page 2 paragraphs 6 and 9). It would have been obvious to Yamanaka to include digital music content representing a music piece that has been modified as the modified digital music content by the one user, who is different from the identified content proprietor to enable users to share their favorite musical contents including remixed songs with their family members and thereby help promote referral business by brining more people to the content provider.

Yamanaka is also silent about the contributing section receiving a digital content from one of the users via the first user terminal together with status information indicating that received digital content is subject to the legal protection and identifying a content proprietor of the received digital content, and registering the modified digital music content into a database. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure

that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign. Furthermore, it's old and well known for users to include status information and content proprietor information as done by those users who may be providing free downloads from their websites for computer programs, to ensure that proper credit goes to the developer and owner of the program and not the distributor of the program and to protect the user from any liability associated with misrepresenting and marketing the content as being his own rather than belonging to the actual developer of the program. Additionally, it is well known to register content posted by users into a database to enable those who are seeking this content to easily locate it as done on free video game download sites for example.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner and to ensure that the owner of the proprietary content receives credit for the content and not the distributor of the content. Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor for paid content as indicated by the data presented from the execution key associated with a particular

content holder for the number of times the content was executed by a user can be made quickly and accurately.

4. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital music contents subject to legal protection (i.e. content owned by creators and holders excluding distributors that requires the use of an execution key) and non-protected digital music contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraphs 2 and 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are delivered to the users via the user terminals (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

5. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital music contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles by the same manufacturer of

the game CD's, and multiple movies by the same movie director) (page 1 paragraphs 2 and 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the digital music contents is delivered to the users via the user terminals (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraphs 2 and 17, page 2 paragraph 25, page 4 paragraph 61, page 7 paragraph 131, page 8 paragraphs 139 and 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

6. In reference to claims 3, 7, 11, and 15, Yamanaka discloses a system, method, a machine readable medium, and computer-readable storage device wherein the allocating section allocates the collected advertisement fees only if registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) digital music content is delivered under the legal protection (page 1 paragraphs 2 and 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 139 and 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal protection) indicating

whether or not the contributed digital contents are subject to the legal protection. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner.

Response to Arguments

7. After careful review of Applicant's remarks/arguments filed on 12/16/2008, the Examiner fully considered the arguments, but they are not persuasive.

8. Applicant submits that remixing music is well known. Applicant argues that in Yamanaka, only the owner (i.e. holder) of the song is allowed to register and distribute music, but that the users do not register and distribute music contents in Yamanaka. The Examiner respectfully disagrees with the Applicant, since the creator of the song does not have to be the holder. Per page 8 paragraph 139 of Yamanaka, the following is recited with respect to holders.

> In cases where the right for digital content is transferred from a creator creating the digital content to a person, the person becomes a holder. Also, in cases where a person is authorized by a creator creating digital content to let a third person use the digital content, the person becomes a holder. For example, the holder denotes an agent of the creator. Also, in cases where a creator created digital content (for example, software), a person who obtains permission from the creator

> to distribute a digital content execution right to a third person is the holder. Also, in cases where a creator creates digital content (for example, a music file, video file or a game software title), a person who obtains a playback right to a third person is the holder. Also, a person who obtains a permission from a creator to distribute digital content created by the creator to a third person is the holder. Also, there is a case that the holder denotes a second holder authorized by a first holder who is authorized by a creator.

As indicated by this section of Yamanaka, a holder is not just the owner or the creator of the music. A holder can be an agent of the creator, who is in a fiduciary relationship with the creator to distribute the music for the creator. In fact, a holder can even be a second holder downstream who is authorized by the first holder, who was authorized by the creator. Furthermore, once you are allowed to remix music by the owner of the music, you become a holder. When a user registers a song and collects advertisements for the owner of a modified song, a user is acting like an owner or an agent of an owner, since otherwise, he would not be legally allowed to profit from the commercially selling the lyrics of an artist without permission. While both a user and a holder can remix music, a holder also has a right to distribute the music for a profit. So, when a user is given the right to remix songs and to make a profit, the user is a holder, unless there is an additional step, method, or system that is performed so that the user does not have the right to remix songs. Once there is an agreement between a user and the owner to share advertisement fees, the user is now a holder. This is why the user, as a holder, has the approval of the owner to do what he wants with the songs. The user as a holder basically has a contract with the owner to make use of the songs in any way he needs to, and in consideration for this contract, he is going to allocate a part of the revenues he receives to the owner of the songs. So, a user is the same as a holder once he has the approval of the owner to make use of the songs in exchange for

sharing revenues with the owner.

Conclusion

9. **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622

/Yehdega Retta/

Primary Examiner, Art Unit 3622